

Remarks

The allowance of claims 1-27 is noted with appreciation.

The examiner has rejected claim 28 under 35 U.S.C. 103 (a) as being unpatentable over Imai et al, U.S. Patent 4,269,052, hereinafter Imai et al. This rejection is not thought to be well taken. The examiner, in applying the Imai et al patent, states:

Imai discloses 4 nozzle assemblies 26 for descaling a continuously strip of metal S, they are divided into pairs of nozzle assembly, each pair covering half surface of the strip metal S with the centerline at L1 as shown in figure 4, each of the nozzle assembly is designed to swing around an axis to adjust the spray width of the nozzle assembly with the width of the metal strip and further to provide a position in which the maintenance and inspection can be done on the nozzle assembly without shutting down the production line as disclosed in column 2, lines 1-37 and column 8, lines 27-37 and also shown in dotted lines in figure 4. Therefore, it would have been obvious to one having ordinary skill in the art to configure the nozzle assemblies of Imai in such away that could provide the production line with operational continuously to maintain one nozzle assembly in each pair of nozzle assembly in an operation position and the other nozzle assembly in an maintenance position. Doing so would provide an effective production line without downtime on the equipments.

From the wording of this rejection, coupled with the section cited, it appears that the examiner is relying on an "obvious" rejection; it is not believed that this rejection can be sustained in view of the burden imposed on the examiner for such a rejection. While it is true what the examiner characterizes Imai et al as showing, the examiner has cited nothing to support the assertion that the modifications would be obvious. Imai et al do show two nozzle assemblies on each side of the strip; however, it is indicated in the reference that the preferred embodiment utilizes each nozzle assembly to cover only one-half of the strip passing thereby. Imai et al also show a plurality of such devices 10 which are comprised of four nozzle arrays to successively spray the strip (Fig. 2). Thus, when Imai et al state that the one nozzle assembly may have maintenance and inspection performed without stopping the production of cold rolled sheet metal, how this is accomplished is not described. One may assume that the multiple descaling

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devices, each comprised of four nozzle assemblies, would account for this ability, or that the accumulator could account for this ability. But certainly there is no suggestion of a first array of nozzles positioned to spray the full width of the strip and mounted for movement to a maintenance station, and a second array normally positioned in a maintenance station and movable to spray the full width of the strip. This is obviously the applicants' concept, which concept is clearly set forth in claim 28.

It is not enough that one may modify a reference, but rather it is required that a second reference suggest such modification of the first reference.

The CAFC stated In re Piasecki, 745 F.2d 1468, 223 USPQ 785, 788 (Fed. Cir. 1984) the following:

"The Supreme Court in Graham v. John Deere Co., 383 U.S. 1 (1966), focused on the procedural and evidentiary processes in reaching a conclusion under Section 103. As adapted to ex parte procedure, Graham is interpreted as continuing to place the "burden of proof on the Patent Office which requires it to produce the factual basis for its rejection of an application under sections 102 and 103". Citing In re Warner, 379 F.2d 1011, 1020, 154 USPQ 173, 177 (CCPA 1967)."

The law is quite clear that in order for a claimed invention to be rejected on obviousness, the prior art must suggest the modifications sought to be patented; In re Gordon, 221 U.S.P.Q. 1125, 1127 (CAFC 1984); ACS Hospital System, Inc. v. Montefiore Hospital, 221 U.S.P.Q. 929, 933 (CAFC 1984). The foregoing principle of law has been followed in Aqua-Aerobic Systems, Inc. v. Richards of Rockford, Inc., 1 U.S.P.Q. 2d, 1945 (D.C. Illinois 1986). In the Aqua-Aerobic's case, the Court stated that the fact that a prior reference can be modified to show the claimed invention does not make the modification obvious unless a prior reference suggests the desirability of the modification.

In In Re Oetiker, 24 U.S.P.Q. 2nd 1443, 1445 (CAFC 1992) held:

"There must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make

the combination. That knowledge can not come from the applicant's invention itself."

Most significantly, the CAFC in the case of In Re Dembiczak, 50 U.S.P.Q.2nd 1614 (CAFC 1999) held at 1617:


"...(examiner can satisfy burden of obviousness in light of combination 'only by showing some objective teaching [leading to the combination]');"

Thus, it is clear that where an individual reference does not teach the entire invention, then the modification which the invention represents must be suggested and motivated by some other reference through some objective teaching and cannot come from the application itself, which is not the case here since there is but one reference cited. Hence, there clearly can be no suggestion of modifications in any way, let alone as suggested by the Examiner.

In view of the above, it is believed that claim 28 is clearly allowable over Imai et al, and such allowance of claim 28, along with claims 1-27, is earnestly solicited.

Respectfully submitted,

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